

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-20.

The following claims are *independent*: 1, 8-14.

Please *amend* claims 1 and 8-14; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 12-13 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and

products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

In the pending rejection, the Examiner alleges "in claims 12 and 13, ... a processor merely is used for identifying at least two member short and long positions ... the method could be carried out by a person ... " (Office Action, p. 4, ¶ 1). Applicant respectfully traverses the rejection and submits previously presented independent claims 12 and 13 are transformative and/or specific structures directed to statutory subject matter.

Applicant further submits amended independent claims 12-13 recite a “processor-implemented method ... comprising: ... identifying via a processor ... executing via the processor the transaction" As such, Applicant submits that independent claims 12-13 are directed to statutory subject matter.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this ground of rejections.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1, 8 and 11-14 under 35 U.S.C. § 112, 2nd paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Although Applicant submits these claims are clear and definite per 35 U.S.C. § 112, Applicant have amended claims 1, 8 and 11-14 herein to provide further clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices.

As such, Applicant respectfully requests reconsideration and withdrawal of the

rejections, and allowance(s) of the claims.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 4, 7-10, 12-13 and 20 under 35 U.S.C. § 102(e) as allegedly unpatentable over Finkelstein, US Pub. No. 2001/0037284 (hereinafter "Finkelstein"), in view of White, Jr., US Patent No. 7,454,378 (hereinafter "White"), and in further view of Louie et al., US Patent 7,599,879 (hereinafter "Louie").

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, “the obviousness or nonobviousness of the subject matter [be] determined,” and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art*.” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and/or **(B)**, and as a consequence, has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant respectfully traverses, and submits that the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact **missing** at least the following element(s) as recited, *inter alia*, in previously pending independent claim 1:

A processor-implemented method for automatically identifying a counter party position for a short or long position, the method comprising:

...

wherein the transaction includes a system-facilitated lending on a pro-rata basis between the selected positions if total selection member long position is greater than total selection member short position for a given financial instrument and borrowing on a pro-rata basis if total selection member short position is greater than total selection member long position for a given financial instrument.

The Office Action acknowledges neither Finkelstein nor White disclose the cited claim elements, but then alleges Louie (at column 2, lines 60-66, column 3, lines 10-37 and column 4, lines 41-47) discusses "system-facilitated lending and borrowing on a pro-rata basis" (Office Action, p. 6, ¶ 2). Applicant respectfully traverses the rejections and submits the Office Action has mischaracterized Louie.

Contrary to the Office Action's assertions, Applicant submits Louie discusses a generic syndicated loan management which facilitates investor access to information with regard to the syndicated loan. For example, Applicant notes the Examiner's cited portions of Louie, column 3, lines 10-37 discuss an "investor can contribute a share of the loan resources, for example a pro-rata share ..." (Louie, Column 3, lines 25-26). Applicant submits Louie's high-level discussion of an investor providing a "pro-rata share" of loan resources, does not teach or suggest any system-facilitated "selected positions," much less the claimed "system-facilitated lending on a pro-rata basis between the selected positions if total selection member long position is greater than total selection member short position for a given financial instrument" and "borrowing on a pro-rata basis if total selection member short position is greater than total selection member long position for a given financial instrument" as recited in independent claim 1.

Applicant further submits the pending rejection has impermissibly dissected the claim elements, analyzing obviousness of the alleged differences of the claim elements over the cited art in isolation and not in respect to the claim elements recited in each claim taken as a whole. For example, as discussed above, the Office Action alleges

"Louie discloses system facilitated lending and borrowing on a pro-rata basis," but failed to treat the claimed:

wherein the transaction includes a system-facilitated lending on a pro-rata basis between the selected positions if total selection member long position is greater than total selection member short position for a given financial instrument and borrowing on a pro-rata basis if total selection member short position is greater than total selection member long position for a given financial instrument.

as a whole. MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." [see, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*: "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicant submits that the pending rejection has only addressed the alleged obviousness of "the differences themselves" and has not addressed "whether the claimed invention as a whole would have been obvious," as required, *inter alia*, by MPEP § 2141.02 (I). Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of the rejection. Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how and specifically why the Examiner believes "the claimed invention as a whole would have been obvious" to one of ordinary skill in the art.

Furthermore, although of different claim scope, Applicant submits that independent claims 8-14 are also patentably distinct from Finkelstein in view of White in view of Louie for at least similar reasons to those discussed above identifying deficiencies in Finkelstein, Louie NY2 - 556565.01

and White with regard to amended independent claim 1. Applicants further submit dependent claims 2-7 and 15-20, which are directly or indirectly dependent from claim 1 and 14, are also patentably distinct from Finkelstein for at least similar reasons to those discussed above identifying deficiencies in Finkelstein and White with regard to the independent claims.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of these grounds of rejections.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertain only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-

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assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-20, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-105. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-105.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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